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PATENT APPLICATION

ATTORNEY DOCKET NO. 10006137-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Terrill, et al.

Confirmation No.: 9168

Application No.: 09/876,354

Examiner: Wu, Qing Yuan

Filing Date: 6-6-01

Group Art Unit: 2194

Title: Print Information Capture and Correlation

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 12-21-05.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Terrill, et al.

Serial No.: 09/876,354

Filed: June 6, 2001

Group Art Unit: 2194

Examiner: Wu, Qing Yuan

Docket No. 10006137-1

For: **Print Information Capture and Correlation**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed December 21, 2005, responding to the Final Office Action mailed September 21, 2005.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

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I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 1-14, 16-20, 22-33, and 35-43 stand finally rejected. No claims have been allowed. The final rejections of claims 1-14, 16-20, 22-33, and 35-43 are appealed.

IV. Status of Amendments

This application was originally filed on June 6, 2001, with thirty-four (34) claims. In a Response filed October 22, 2004, Applicant amended claims 1, 16, 22, 27-30, and 32, canceled claims 15, 21, and 34, and added new claims 35-37. In a Response filed June 27, 2005, Applicant added new claims 38-43. In a Response filed October 21, 2005, Applicant amended claims 7, 8, 10, 16, 18, and 36.

All of the above-identified amendments have been entered except for the those of the Response filed October 21, 2005, which the Examiner alleges raise “new issues.” The claims in the attached Claims Appendix (see below) reflect the present state of the claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description (“specification”) and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 1 describes a computer-implemented method, comprising associating a print job with a unique job identifier prior to sending the job to a printing device. Applicant’s specification, page 3, lines 11-12; page 6, lines 7-8; page 10, lines 6-8; page 14, lines 17-18; Figure 3, item 304.

The method of claim 1 further comprises obtaining pre-print information about the print job. Applicant’s specification, page 3, lines 14-15; page 6, lines 9-10; page 10, lines 14-16; page 14, lines 22-23; Figure 3, item 308.

The method of claim 1 further comprises obtaining post-print information about the print job. Applicant’s specification, page 3, lines 19-20; page 6, lines 14-15; page 11, lines 13-14; page 15, lines 4-5; Figure 3, item 312.

The method of claim 1 further comprises correlating the pre-print information and the post-print information using the unique job identifier. Applicant’s specification, page

4, lines 3-4; page 6, lines 16-17; page 11, lines 21-22; page 15, lines 14-16; Figure 3, item 316.

Independent claim 16 describes a computer-implemented method of capturing print job information, comprising configuring a port monitor with a server. Applicant's specification, page 8, line 24 to page 9, line 5.

The method of claim 16 further comprises associating a print job received by the port monitor with a unique job identifier prior to sending the job to a printer. Applicant's specification, page 3, lines 11-12; page 6, lines 7-8; page 10, lines 6-8; page 14, lines 17-18; Figure 3, item 304.

The method of claim 16 further comprises sending the print job to the printer. Applicant's specification, page 6, lines 8-9; page 14, lines 20-21; Figure 3, item 306.

The method of claim 16 further comprises obtaining pre-print information about the print job. Applicant's specification, page 3, lines 19-20; page 6, lines 14-15; page 11, lines 13-14; page 15, lines 4-5; Figure 3, item 312.

The method of claim 16 further comprises correlating the pre-print information and the post-print information using the unique job identifier. Applicant's specification, page 4, lines 3-4; page 6, lines 16-17; page 11, lines 21-22; page 15, lines 14-16; Figure 3, item 316.

Independent claim 22 describes a computer-implemented method, comprising receiving a print job with a port monitor. Applicant's specification, page 14, lines 14-16; Figure 3, item 302.

The method of claim 22 further comprises wrapping the print job with a unique job identifier to form a wrapped print job. Applicant's specification, page 14, lines 20-21; Figure 3, item 306.

The method of claim 22 further comprises sending the wrapped print job to a printer. Applicant's specification, page 14, lines 20-21; Figure 3, item 306.

The method of claim 22 further comprises obtaining pre-print information associated with the print job from an operating system. Applicant's specification, page 3, lines 14-15; page 6, lines 9-10; page 10, lines 14-16; page 14, lines 22-23; Figure 3, item 308.

The method of claim 22 further comprises polling the printer to determine if the print job is done. Applicant's specification, page 6, lines 10-11; page 15, lines 1-2; Figure 3, item 310.

The method of claim 22 further comprises obtaining post-print information from the printer. Applicant's specification, page 3, lines 19-20; page 6, lines 14-15; page 11, lines 13-14; page 15, lines 4-5; Figure 3, item 312.

The method of claim 22 further comprises correlating the pre-print and post-print information to produce correlated information. Applicant's specification, page 4, lines 3-4; page 6, lines 16-17; page 11, lines 21-22; page 15, lines 14-16; Figure 3, item 316.

Independent claim 27 describes a port monitor (item 128 Figure 1) that operates on a peripheral server (item 104, Figure 1). Applicant's specification, page 8, lines 3-11; Figure 2.

The port monitor of claim 27 comprises a job information collection module (item 210, Figure 2) configured to assign unique job identifiers to print jobs and to collect and

correlate pre-print and post-print information, the pre-print information being obtained from a host operating system and the post-print information being obtained from a peripheral device that is configured to print jobs. Applicant's specification; page 14, lines 17-18 and 22-23; page 15, lines 4-5 and 14-16; Figure 3, items 304, 308, 312, and 316.

Independent claim 31 describes at least one computer-readable media having computer readable instructions thereon, which when executed by a computer, cause the computer to receive a print job. Applicant's specification, page 14, lines 14-16; Figure 3, item 302.

The instructions of claim 31 further cause the computer to of claim 31 further cause a computer to wrap the print job with a unique job identifier to create a wrapped print job. Applicant's specification, page 14, lines 20-21; Figure 3, item 306.

The instructions of claim 31 further cause the computer to of claim 31 further cause a computer to send the wrapped print job to a printer. Applicant's specification, page 14, lines 20-21; Figure 3, item 306.

The instructions of claim 31 further cause the computer to of claim 31 further cause a computer to obtain pre-print information from an operating system. Applicant's specification, page 3, lines 14-15; page 6, lines 9-10; page 10, lines 14-16; page 14, lines 22-23; Figure 3, item 308.

The instructions of claim 31 further cause the computer to of claim 31 further cause a computer to obtain post-print information from the printer. Applicant's specification, page 3, lines 19-20; page 6, lines 14-15; page 11, lines 13-14; page 15, lines 4-5; Figure 3, item 312.

The instructions of claim 31 further cause the computer to of claim 31 further cause a computer to correlate the pre-print information and the post-print information associated with the unique job identifier. Applicant's specification, page 4, lines 3-4; page 6, lines 16-17; page 11, lines 21-22; page 15, lines 14-16; Figure 3, item 316.

Independent claim 35 describes a computer-readable medium having computer-readable instructions for associating a print job with a unique job identifier prior to sending the job to a printing device, obtaining pre-print information about the print job, obtaining post-print information about the print job, and correlating the pre-print information and the post-print information using the unique job identifier. Applicant's specification; page 14, lines 17-18 and 22-23; page 15, lines 4-5 and 14-16; Figure 3, items 304, 308, 312, and 316.

Independent claim 36 describes a computer-readable medium having computer-readable instructions for configuring a port monitor of a server, associating a print job received by a port monitor with a unique job identifier prior to sending the job to a printer, sending the print job to the printer, obtaining pre-print information about the print job, obtaining post-print information about the print job, correlating the pre-print information and the post-print information using the unique job identifiers. Applicant's specification; page 6, lines 8-9; page 8, line 24 to page 9, line 5; page 14, lines 17-18 and 20-23; page 15, lines 4-5 and 14-16; Figure 3, items 304, 306, 308, 312, and 316.

Independent claim 37 describes a computer having a processor capable of reading a computer-readable medium to execute instructions to cause the computer to receive a print job, wrap the print job with a unique job identifier to create a wrapped print job, send the wrapped print job to a printer, obtain pre-print information from an operating

system, obtain post-print information from the printer, and correlate the pre-print information and the post-print information associated with the unique job identifier. Applicant's specification; page 14, lines 14-23; page 15, lines 4-16; Figure 3, items 302, 304, 306, 308, 312, and 316.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed on appeal:

1. Claims 7-11 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

2. Claims 1-14, 16-20, 22-33, and 35-43 and have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's "admitted prior art" ("AAPA") in view of Kujirai, et al. ("Kujirai," U.S. Pat. No. 6,618,566) and further in view of Kassan, et al. ("Kassan," U.S. Pub. No. 2002/0161717).

VII. Arguments

Applicant respectfully submits that Applicant's claims are not indefinite under 35 U.S.C. § 112 or obvious under 35 U.S.C. § 103, and respectfully requests that the Board of Patent Appeals overturn the final rejections of those claims at least for the reasons discussed below.

A. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 7-11 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In particular, the Examiner states that claims 7 and 8 should identify a unique "job" identifier, and that claims 7-11 are allegedly unclear as to whether the various information identified in claims 7-11 is correlated "prior to sending."

In response to the omission of the term "job", Applicant attempted to amend claims 7 and 8 to replace "unique identifier" with "unique job identifier". The Examiner chose, however, to not enter the amendments.

Regarding the alleged lack of clarity regarding the "information" discussed in claims 7-11, Applicant submits that the claims are not indefinite for merely not identifying whether the information recited in the claims is or is not correlated. Instead, those claims are open as to that aspect, and are therefore broad in that regard. Nothing is ambiguous, however, about, for example, "sending the unique job identifier, the pre-print information, and the post-print information to a job table on a peripheral". By analogy, if a claim recited a "shaft" but did not state what the shaft was made of, the claim is not indefinite but instead is broad as to that

aspect of the invention. In view of the above, claims 7-11 were not amended to identify whether or not the information recited in those claims is “correlated prior to sending”.

In view of the foregoing, Applicant respectfully requests that the rejections to claims 7-11 be overturned.

B. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-14, 16-20, 22-33, and 35-43 and have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant’s “admitted prior art” (“AAPA”) in view of Kujirai, et al. (“Kujirai,” U.S. Pat. No. 6,618,566) and further in view of Kassan, et al. (“Kassan,” U.S. Pub. No. 2002/0161717). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach

or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations. Applicant discusses the rejections in the following.

1. The Kujirai Disclosure

Kujirai discloses a print control apparatus for generating accounting information relating to a print job. Kujirai, Patent Title. As is described in the reference, the Kujirai system includes a "job accounting client application" that monitors a system spooler and acquires information relevant to accounting, such as the number of sheets discharged by a printer to print the user's print job. Kujirai, column 5, lines 34-39. Later in the disclosure, Kujirai states that "information" is transferred from the user's printer driver to the job accounting client application 205, and that the information includes a "job identifier 402." Kujirai, column 7, lines 30-51.

2. The Kassan Disclosure

Kassan discloses a method and system for correlating job accounting information with software license information. Kassan, Patent Title. More specifically, Kassan discloses a system that collects and maintains cost and usage data relative to a resource (e.g., system connect time) for purposes of charging users for use of the resource. Kassan, column 1, paragraphs 0002-0005. At one point in the disclosure, Kassan states the

following: “In yet another embodiment (G), the user-id is used to correlate license dialogs with job processing information.” Kassan, paragraph 0173.

3. Discussion of the Merits of the Rejection

(a) Claims 1-14 and 38-43

Independent claim 1 provides as follows (emphasis added):

1. A computer-implemented method, comprising:
associating a print job with a unique job identifier prior to sending the job to a printing device;
obtaining pre-print information about the print job;
obtaining post-print information about the print job; and
correlating the pre-print information and the post-print information using the unique job identifier.

As is indicated in claim 1, recited are associating a print job with a “unique job identifier”, “obtaining pre-print information”, “obtaining post-print information”, and the “correlating the pre-print information and the post-print information *using the unique job identifier*” (emphasis added).

In the final Office Action, the Examiner argued that Applicant admits that obtaining pre-print information, obtaining post-print information, and correlating the pre-print and post-print information is known, but that Applicant does not admit that correlating the pre-print and post-print information using a unique job identifier is known. For that missing teaching, the Examiner relies upon Kujirai and Kassan. Regarding Kujirai, the Examiner argues that Kujirai teaches “associating a job identifier with a print job when spooling the

print job.” Regarding Kassan, the Examiner argues that Kassan teaches “correlating information based on an identifier.”

Applicant notes that, even if all of the above Examiner arguments are presumed to be true, the combination of Applicant’s alleged admissions, Kujirai, and Kassan would *still* not support a proper case of obviousness under 35 U.S.C. § 103. Applicant describes the reasons for this conclusion in the following.

(i) No Motivation to Combine Exists

As a first matter, Applicant submits that there is absolutely no proper motivation to combine the teachings of Kujirai and Kassan with the process of collecting pre-print and post-print information. As is noted above, both Kujirai and Kassan pertain to accounting systems, i.e., systems that track use of a resource for purposes of charging the user for that use. The alleged Applicant admissions say nothing about accounting. Applicant further notes that just because the Examiner believes that Applicant admits that part of the claimed invention is known, the Examiner is not excused from the requirement of identifying a suggestion or motivation in the prior art to modify the alleged known aspects to include the aspects taught by prior art references.

(ii) Applicant’s Claims Being Considered in a Piecemeal Fashion

As a second matter, it appears clear that Applicant’s claims are being considered in a piecemeal fashion. In other words, the Office Action identifies various references, each purportedly teaching a discrete element of Applicant’s claims. What is missing, however, is an overall teaching that actually ties the teachings of the references together. As is well

established in the law, the Examiner must consider the claims as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, “the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed”). Accordingly, the Examiner cannot simply piece together multiple references to separately account for each explicit limitation in an effort to manufacture a rejection of Applicant’s claims.

When Applicant’s claims are considered as a whole, it is clear that the proposed combination does not render Applicant’s claims obvious. Even assuming there were an adequate teaching or suggestion to combine the references, such combination would still not result in Applicant’s claimed inventions. For example, even though Kujirai mentions a “job identifier” used for accounting purposes and Kassan teaches a “user-id” that is used to correlate “license dialogs” with “job processing information,” the fact remains that these teachings do not render obvious “correlating the pre-print information and the post-print information using the unique job identifier” as is explicitly recited in Applicant’s claim 1 (similar recitations are contained in other claims). *Nothing* in either reference contains the “missing link” that would inspire a person having ordinary skill in the art to make the modifications to the alleged admitted system required to arrive at Applicant’s claimed inventions in the manner suggested in the Office Action.

(iii) The Missing Teaching Comes from Applicant's Disclosure, Not the Prior Art

As a third matter, it is clear that the only teaching of “correlating the pre-print information and the post-print information *using the unique job identifier*” (emphasis added) comes from Applicant’s own disclosure. In other words, there is nothing in the prior art, or in Applicant’s Background section, that would teach or suggest to a person having ordinary skill in the art to use Kujirai’s job identifier to correlate pre-print and post-print information. Furthermore, there is nothing in the art, or in Applicant’s Background section, that would suggest to such a person to use Kassan’s teaching as to correlating “license dialogs” with “job processing information” to correlate pre-print and post-print information using a job identifier. It is Applicant’s *own disclosure*, which is not admitted as prior art, that actually provides the missing teaching. Without that teaching, a person having ordinary skill would simply not arrive at the claimed invention. As is well established in the law, such hindsight to the Applicant’s own disclosure or claims is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention).

(iv) Dependent Claims

The claims that depend from claim 1 contain further limitations that are not taught or suggested by the prior art. For example, regarding dependent claim 2, Applicant’s so-called admitted prior art does not include a teaching of receiving pre-print information

“from an operating system”. Specifically, page 1, lines 25-26 of Applicant’s specification do *not* describe such an aspect.

Regarding dependent claim 5, Applicant’s so-called admitted prior art does not include a teaching of receiving post-print information through the use of “SNMP Gets”. Specifically, page 2, lines 1-4 of Applicant’s specification do *not* describe anything about SNMP Gets.

Regarding dependent claim 6, Applicant’s so-called admitted prior art does not include a teaching of storing a “unique identifier, the pre-print information and the post-print information”. Specifically, page 2, lines 1-4 of Applicant’s specification do *not* describe anything about storing any “unique identifier”.

Regarding dependent claim 7, the Examiner provides *no support whatsoever* for the alleged obviousness of sending the unique identifier, the pre-print information, and the post-print information “to a job table on a peripheral”. Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding dependent claims 10 and 11, the Examiner provides *no support whatsoever* for the alleged obviousness of a “time threshold”, a “storage level threshold”, or a “print job quantity threshold”, or of “adjusting a value at which the threshold triggers the transfer of data”. Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding dependent claims 12 and 13, the Examiner provides *no support whatsoever* for the alleged obviousness of “polling a peripheral to determine if the peripheral has finished with the print job” or “varying the rate of polling as the peripheral

works on the print job”. Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

(b) Claims 16-20

Independent claim 16 provides as follows (emphasis added):

16. A computer-implemented method of capturing print job information, comprising:

configuring a port monitor with a management server;

associating a print job received by a port monitor with a unique job identifier prior to sending the job to a printer;

sending the print job to the printer;

obtaining pre-print information about the print job;

obtaining post-print information about the print job; and

correlating the pre-print information and the post-print information using the unique job identifier.

Regarding claim 16, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier. Claim 16 and its dependents are allowable for at least the same reasons as claim 1.

Regarding dependent claim 17, the Examiner provides *no support whatsoever* for the alleged obviousness of “configuring a plurality of port monitors” to have a given threshold. Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding claims 19 and 20, Applicant refers back to the discussion of claims 12 and 13 provided above.

(c) Claims 22-26

Independent claim 22 provides as follows (emphasis added):

22. A computer-implemented method, comprising:
receiving a print job with a port monitor;
wrapping the print job with a unique job identifier to form a wrapped print job;
sending the wrapped print job to a printer;
obtaining pre-print information associated with the print job from an operating system;
polling the printer to determine if the print job is done;
obtaining post-print information from the printer; and
correlating the pre-print and post-print information to produce correlated information.

Regarding claim 22, Applicant refers to the discussion provided above in relation to claim 1 regarding providing a “unique job identifier” to a print job. As a further point, Applicant notes that neither the alleged admitted prior art or cited references teach or suggest “wrapping the print job” with a unique job identifier to form a “wrapped print job”. *Applicant notes that the Examiner has ignored that explicit limitation in rejecting claim 22.* Specifically, the Examiner only refers to the Examiner’s discussion of previous claims, which do not include the “wrapping” limitation. Furthermore, the prior art does not teach or suggest obtaining pre-print information “from an operating system”. Again, as is noted above, in regard to claim 2, page 1, lines 25-26 of Applicant’s specification do

not describe such an aspect. Moreover, the prior art does not teach or suggest “polling the printer to determine if the print job is done”. Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding dependent claim 23, Applicant refers back to the discussion of claim 13.

Regarding dependent claims 24-26, the Examiner provides *no support whatsoever* for the alleged obviousness of the various “threshold” limitations explicitly recited in claims 24-26.

(d) Claims 27-30

Independent claim 27 provides as follows (emphasis added):

27. A ***port monitor*** that operates on a peripheral server, comprising:

a job information collection module configured to ***assign unique job identifiers to print jobs*** and to collect and correlate pre-print and post-print information, the ***pre-print information being obtained from a host operating system*** and the post-print information being obtained from a peripheral device that is configured to print jobs.

As an initial matter regarding claim 27, the prior art does not teach or suggest a “port monitor” at all. Claim 27 and its dependents are allowable for at least that reason.

As a further matter, the prior art does not teach or suggest that such a port monitor is configured “to assign unique job identifiers to print jobs and to collect and correlate pre-print and post-print information, the pre-print information being obtained from a host operating system and the post-print information being obtained from a peripheral device

that is configured to print jobs”, at least for reasons discussed above in relation to claim 1.

Regarding dependent claim 30, Applicant’s so-called admitted prior art does not include a teaching of receiving post-print information through the use of “SNMP Gets”. Specifically, page 2, lines 1-4 of Applicant’s specification do *not* describe anything about SNMP Gets.

(e) Claims 31-33

Independent claim 31 provides as follows (emphasis added):

31. At least one computer-readable media having computer readable instructions thereon, which when executed by a computer, cause the computer to:

receive a print job;

wrap the print job with a unique job identifier to create a wrapped print job;

send the wrapped print job to a printer;

obtain pre-print information from an operating system;

obtain post-print information from the printer; and

correlate the pre-print information and the post-print information associated with the unique job identifier.

In regard to claim 31, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier. Claim 31 and its dependents are allowable for at least the same reasons as claim 1.

Regarding dependent claim 32, Applicant refers back to the discussion of “polling” provided above in relation to claim 12.

Regarding dependent claim 33, Applicant refers back to the discussion of varying a rate of polling provided above in relation to claim 13.

(f) Claim 35

Independent claim 35 provides as follows (emphasis added):

35. A computer-readable medium having computer-readable instructions for performing the following:

associating a print job with a unique job identifier prior to sending the job to a printing device;

obtaining pre-print information about the print job;

obtaining post-print information about the print job; and

correlating the pre-print information and the post-print information using the unique job identifier.

Regarding claim 35, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier.

(g) Claim 36

Independent claim 36 provides as follows (emphasis added):

36. A computer-readable medium having computer-readable instructions for performing the following:

configuring a port monitor with a management server;

associating a print job received by a port monitor with a unique job identifier prior to sending the job to a printer;
sending the print job to the printer;
obtaining pre-print information about the print job;
obtaining post-print information about the print job; and
correlating the pre-print information and the post-print information using the unique job identifiers.

Regarding claim 36, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier.

(h) Claim 37

Independent claim 37 provides as follows (emphasis added):

37. A computer having a processor capable of reading a computer-readable medium to execute instructions to cause the computer to:

receive a print job;
wrap the print job with a unique job identifier to create a wrapped print job;
send the wrapped print job to a printer;
obtain pre-print information from an operating system;
obtain post-print information from the printer; and
correlate the pre-print information and the post-print information associated with the unique job identifier.

Regarding claim 37, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier.

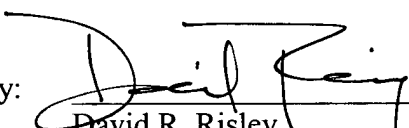
As a further point, Applicant notes that neither the alleged admitted prior art or cited references teach or suggest “wrapping the print job” with a unique job identifier to form a “wrapped print job”. *Applicant notes that the Examiner has ignored that explicit limitation in rejecting claim 37.* Furthermore, the prior art does not teach or suggest obtaining pre-print information “from an operating system”. Again, as is noted above, in regard to claim 2, page 1, lines 25-26 of Applicant’s specification do *not* describe such an aspect. Moreover, the prior art does not teach or suggest “polling the printer to determine if the print job is done”. Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

VII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:


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22313-1450 on:

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2-3-06
Mary M. Legan

Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A computer-implemented method, comprising:
associating a print job with a unique job identifier prior to sending the job to a printing device;
obtaining pre-print information about the print job;
obtaining post-print information about the print job; and
correlating the pre-print information and the post-print information using the unique job identifier.
2. A method as recited in claim 1, wherein the pre-print information is received from an operating system.
3. A method as recited in claim 1, wherein the post-print information is obtained from a peripheral.
4. A method as recited in claim 3, wherein the peripheral is selected from among a group of peripherals comprising a printer and a facsimile machine.
5. A method as recited in claim 1, wherein the obtaining post-print information step comprises use of SNMP Gets.

6. A method as recited in claim 1, further comprising storing the unique identifier, the pre-print information and the post-print information.

7. A method as recited in claim 1, additionally comprising sending the unique identifier, the pre-print information and the post-print information to a job table on a peripheral.

8. A method as recited in claim 1, additionally comprising sending the unique identifier, the pre-print information and the post-print information to a management server.

9. A method as recited in claim 1, further comprising transferring the pre-print information and the post-print information to a management server upon realization of a threshold.

10. A method as recited in claim 9, wherein the threshold is selected from a group of thresholds comprising an elapsed time threshold, a storage level threshold and a print job quantity threshold.

11. A method as recited in claim 9, additionally comprising adjusting a value at which the threshold triggers the transfer of data.

12. A method as recited in claim 1, additionally comprising polling a peripheral to determine if the peripheral has finished with the print job.

13. A method as recited in claim 12, wherein the polling step comprises varying the rate of polling as the peripheral works on the print job.

14. A method as recited in claim 1, additionally comprising requesting the peripheral to send a trap with print information.

15. (Canceled)

16. A computer-implemented method of capturing print job information, comprising:

configuring a port monitor with a management server;

associating a print job received by a port monitor with a unique job identifier prior to sending the job to a printer;

sending the print job to the printer;

obtaining pre-print information about the print job;

obtaining post-print information about the print job; and

correlating the pre-print information and the post-print information using the unique job identifier.

17. A method as recited in claim 16, wherein configuring comprises configuring a plurality of port monitors to have a same threshold value.

18. A method as recited in claim 16, wherein configuring comprises generating a user interface on the management server that is supported by HTML.

19. A method as recited in claim 16, additionally comprising polling the printer to determine if the printer has finished with the print job.

20. A method as recited in claim 16, wherein the polling step comprises varying the rate of polling as the printer works on the print job.

21. (Canceled)

22. A computer-implemented method, comprising:
receiving a print job with a port monitor;
wrapping the print job with a unique job identifier to form a wrapped print job;
sending the wrapped print job to a printer;
obtaining pre-print information associated with the print job from an operating system;
polling the printer to determine if the print job is done;
obtaining post-print information from the printer; and

correlating the pre-print and post-print information to produce correlated information.

23. A method as recited in claim 22, wherein polling comprises polling at a varying rate as the printer works on the print job.

24. A method as recited in claim 22, additionally comprising triggering the transfer of correlated information to a management server upon reaching a threshold.

25. A method as recited in claim 24, wherein the threshold is selected from a group of thresholds comprising an elapsed time threshold and a storage available threshold.

26. A method as recited in claim 24, additionally comprising adjusting the threshold that triggers the transfer of data.

27. A port monitor that operates on a peripheral server, comprising:
a job information collection module configured to assign unique job identifiers to print jobs and to collect and correlate pre-print and post-print information, the pre-print information being obtained from a host operating system and the post-print information being obtained from a peripheral device that is configured to print jobs.

28. The port monitor of claim 27, additionally comprising a data store in communication with the job information collection module, the data store being configured to store the pre-print and post-print information.

29. The port monitor of claim 27, additionally comprising a data transfer module in communication with the job information collection module, the data transfer module being configured to transfer data from the job information collection module.

30. The port monitor of claim 27, additionally comprising an SNMP module in communication with the job information collection module.

31. At least one computer-readable media having computer readable instructions thereon, which when executed by a computer, cause the computer to:

- receive a print job;
- wrap the print job with a unique job identifier to create a wrapped print job;
- send the wrapped print job to a printer;
- obtain pre-print information from an operating system;
- obtain post-print information from the printer; and
- correlate the pre-print information and the post-print information associated with the unique job identifier.

32. A computer-readable media as recited in claim 31, to additionally cause the computer to poll to determine if the printer has finished with the print job.

33. A computer-readable media as recited in claim 32, to additionally cause the computer to vary a rate of polling as the printer works on the print job.

34. (Canceled)

35. A computer-readable medium having computer-readable instructions for performing the following:

associating a print job with a unique job identifier prior to sending the job to a printing device;

obtaining pre-print information about the print job;

obtaining post-print information about the print job; and

correlating the pre-print information and the post-print information using the unique job identifier.

36. A computer-readable medium having computer-readable instructions for performing the following:

configuring a port monitor with a management server;

associating a print job received by a port monitor with a unique job identifier prior to sending the job to a printer;

sending the print job to the printer;

obtaining pre-print information about the print job;

obtaining post-print information about the print job; and

correlating the pre-print information and the post-print information using the unique job identifiers.

37. A computer having a processor capable of reading a computer-readable medium to execute instructions to cause the computer to:

receive a print job;

wrap the print job with a unique job identifier to create a wrapped print job;

send the wrapped print job to a printer;

obtain pre-print information from an operating system;

obtain post-print information from the printer; and

correlate the pre-print information and the post-print information associated with the unique job identifier.

38. The method of claim 1, wherein the associating is performed by a print server that receives the print job from a user device and forwards the print job to the printing device.

39. The method of claim 1, wherein the pre-print information includes information as to an owner of the document.

40. The method of claim 1, wherein the pre-print information includes information as to an application that was used to create the document.

41. The method of claim 1, wherein the post-print information includes information as to time required to print.

42. The method of claim 1, wherein the post-print information includes information as to a quantity of toner used to print.

43. The method of claim 1, wherein the post-print information includes information as to success or failure of printing.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.